

**Amendment and Response**

Applicant: John L. Manuel et al.

Serial No.: 10/702,151

Filed: November 5, 2003

Docket No.: 200300161-1

Title: SYSTEM AND METHOD FOR CREATING A BEST-MATCH OBJECT AT RUN TIME

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**REMARKS**

The following Remarks are made in response to the Non-Final Office Action mailed February 24, 2009, in which claim 33 was allowed, claims 1-19, 23, 31, and 35-44 were rejected, and claims 20-22 and 34 were objected to.

With this Amendment, claims 21 and 22 have been cancelled without prejudice, claims 45-49 have been added, and claims 20, 34, and 40 have been amended, including allowable claim 20 which has been rewritten in independent form.

Claims 1-20, 23, 31, and 33-49, therefore, remain pending in the application and are presented for reconsideration and allowance.

**Claim Objections**

Claims 34 and 40 are objected to as being directed to a computer program product that is not stored and executed by a processor.

With this Amendment, Applicant has amended claims 34 and 40 as recommended by the Examiner. Applicant, therefore, respectfully requests that the objection to claims 34 and 40 be reconsidered and withdrawn.

**Claim Rejections under 35 U.S.C. § 103**

Claims 1-19, 23, 31, and 35-44 are rejected under 35 U.S.C. 103(a) as unpatentable over Zehler U.S. Publication No. 2004/0136027 in view of Thompson U.S. Publication No. 2004/0210661.

Applicant respectfully traverses this rejection.

Applicant notes that the publication date of the Thompson Patent Application Publication is Oct. 21, 2004, and the filing date of the Thompson Patent Application Publication is Jan. 14, 2004. The filing date of the present application, however, is Nov. 5, 2003. Thus, the filing date of the present application precedes the filing date of the Thompson Patent Application Publication.

Applicant recognizes that the first paragraph [0001] of the Thompson Patent Application Publication provides that:

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*This application claims priority to U.S. Provisional Application Serial No. 60/440,186 filed on Jan. 14, 2003 which is fully incorporated by reference herein.*

Applicant submits, however, that before the Thompson Patent Application Publication can rely on Jan. 14, 2003 as the effective date in a rejection under 35 U.S.C. 102(e) (or as a 102(e) reference in a rejection under 35 U.S.C. 103(a)), a determination must be made as to whether the subject matter used to make the rejection is appropriately supported in the replied upon earlier-filed application's disclosure (see MPEP 706.02(f)(1) and MPEP 706.02(i)). As outlined in MPEP 706.02(f)(1)(emphasis added):

*The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph.*

More importantly, regarding priority from a provisional application under 35 U.S.C. 119(e), as outlined in MPEP 2136.03 III (emphasis added):

*The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph. See MPEP § 706.02(f)(1).*

Accordingly, the filing date of a prior provisional application may only be relied upon in a rejection under 35 U.S.C. 102(e) **if the prior provisional application properly supports the subject matter used or relied upon to make the rejection.** Conversely, subject matter not supported by the prior provisional application is not entitled to the benefit of the earlier filing date.

In this instance, with regard to the Thompson Patent Application Publication, subject matter not disclosed in Provisional Application No. 60/440,186 is not entitled to the benefit of the earlier filing date. Applicant, therefore, submits that a determination must be made as to whether the subject matter of the Thompson Patent Application Publication used to make

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the rejection of claims 1-19, 23, 31, and 35-44 under 35 U.S.C. 103(a) is appropriately supported in Provisional Application No. 60/440,186.

In the rejection of independent claims 1, 8, 14, 31, 35, and 40 under 35 U.S.C. 103(a), the Examiner relies on the subject matter of paragraph [0037] of the Thompson Patent Application Publication. Upon Applicant's review of Provisional Application No. 60/440,186, Applicant submits that the subject matter of paragraph [0037] of the Thompson Patent Application Publication as relied on in the rejection of independent claims 1, 8, 14, 31, 35, and 40 under 35 U.S.C. 103(a), is not disclosed in Provisional Application No. 60/440,186. Thus, with regard to at least this subject matter, Applicant submits that the Thompson Patent Application Publication is not entitled to the benefit of the earlier filing date of Provisional Application No. 60/440,186.

Accordingly, with regard to at least the subject matter of paragraph [0037] of the Thompson Patent Application Publication as relied on in the rejection of independent claims 1, 8, 14, 31, 35, and 40 under 35 U.S.C. 103(a), Applicant submits that the effective date of the Thompson Patent Application Publication is the filing date of Jan. 14, 2004. As outlined above, the filing date of the present application, however, is Nov. 5, 2003. Thus, the filing date of the present application precedes the effective date of the Thompson Patent Application Publication with regard to at least this subject matter.

In view of the above, with regard to at least the subject matter of paragraph [0037] of the Thompson Patent Application Publication, Applicant submits that the Thompson et al. U.S. Patent Application Publication No. 2004/0210661 does not qualify as a reference under 35 U.S.C. 102(e) and, therefore, does not qualify as a reference under 35 U.S.C. 103(a). Applicant, therefore, respectfully requests that the rejection of claims 1-19, 23, 31, and 35-44 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 1-19, 23, 31, and 35-44 be allowed.

**Allowable Subject Matter**

Applicant agrees with the Examiner's conclusions regarding patentability without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicant submits that the above-identified claims are allowable because the prior art fails to

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teach, anticipate or render obvious the invention as claimed, independent of how the invention is paraphrased.

Claim 33 is allowable. Applicant appreciates the indicated allowance of claim 33.

Claim 34 is objected to, but it would be allowable if amended to include a storing and execution of the computer program product.

With this Amendment, Applicant has amended claim 34 as recommended by the Examiner. Applicant, therefore, respectfully requests that claim 34 be allowed.

Claims 20-22 are objected to as being dependent upon a rejected base claim, but would be allowable if the combination of claims 20-22 is rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With this Amendment, Applicant has rewritten the combination of allowable claims 20-22 in independent form to include all of the limitations of the base claim (claim 14) and any intervening claims (none). Applicant, therefore, respectfully requests that the objection to claims 20-22 be withdrawn and that claim 20 be allowed.

**New Claims**

With this Amendment, Applicant has new claims 45-49 with new claim 45 depending from independent claim 1, new claim 46 depending from independent claim 8, new claim 47 depending from independent claim 31, new claim 48 depending from independent claim 35, and new claim 49 depending from independent claim 40. As such, new claims 45-47 each include limitations similar to allowed claims 20-22, and new claims 48 and 49 each include limitations similar to allowed claim 33. Applicant, therefore, respectfully requests that new claims 45-49 be allowed.

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**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1-20, 23, 31, and 33-49 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Respectfully submitted,

John L. Manuel et al.,

By,

DICKE, BILLIG & CZAJA, PLLC  
Fifth Street Towers, Suite 2250  
100 South Fifth Street  
Minneapolis, MN 55402  
Telephone: (612) 573-2006  
Facsimile: (612) 573-2005

Date: MAY 22, 2009  
SAL:skh

/SCOTT LUND/  
Scott A. Lund  
Reg. No. 41,166